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AF/3622
DPE

TRANSMITTAL LETTER

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RE: Attorney Docket No.: CAT29US-SCROCO
Application Serial No.: 09/401,939
Filed: September 23, 1999
Title: SYSTEM AND METHOD FOR SHOPPING AIDS AND
INCENTIVES TO CUSTOMERS THROUGH A COMPUTER
NETWORK
Inventor: SCROGGIE, Michael C.
Group Art Unit: 3622
Examiner: GRAVINI, S

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AUG 15 2003

GROUP 3600

SIR:

Attached hereto for filing are the following papers:

**Request for Reconsideration of Decision on 37 CFR 1.181 Petition to Remove Final Status,
Paper No. 20, Mailed July 25, 2003
Attachments 1 & 2**

Our check in the amount of \$0.00 is attached covering the required fees.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106. A duplicate copy of this sheet is enclosed.

31518

PATENT TRADEMARK OFFICE

8/12/03
Date

[Signature]
Richard A. Neifeld, Ph.D.
Registration No. 35,299

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#22



DOCKET NO: CAT/29US-SCROCO
PRIOR DOCKET NO.: 7791-0087-25 CONT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:
MICHAEL C. SCROGGIE ET AL.

:
: GROUP: 3622

RECEIVED

AUG 15 2003

APPLICATION NUMBER: 09/401,939

: EXAMINER: GRAVINI, S.

GROUP 3600

FILED: September 23, 1999

:

FOR: SYSTEM AND METHOD FOR PROVIDING SHOPPING AIDS AND INCENTIVES
TO CUSTOMERS THROUGH A COMPUTER NETWORK

REQUEST FOR RECONSIDERATION OF DECISION ON 37 CFR 1.181 PETITION TO
REMOVE FINAL STATUS, PAPER NO. 20, MAILED JULY 25, 2003

I. Statement of the Relief Requested

The applicant requests reconsideration of the decision denying the petition to have the final status removed to the extent necessary to admit the evidence attached to the applicant's appeal brief.¹

II. Statement of the Additional Material Facts

1. The only change to claims in the amendment filed October 23, 2002 in response to the first office action was removal of either the words "the steps of:" or the words "said step of".
2. The rejections based upon the Examiner's personal knowledge in the first office action mailed 7/29/2002 were rejections of canceled claims 1-20.
3. The rejections based upon the examiner's affidavit contained in the final office action mailed 11/22/2002 were of pending claims 32-70.
4. 37 CFR 1.104(d)(2) states that:

¹A copy of a date stamped filing receipt dated March 14, 2003, copy of a check for \$130.00 and 37 CFR 1.181 Petition to Remove Final Status are attachment 1 to this request.

A copy of paper number 20, entitled "DECISION ON PETITION UNDER 37 CFR 1.181 TO REMOVE FINAL STATUS" is attachment 2.

When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, ***and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.***

5. The decision on the petition stated that "the petition is premature because the Examiner has not yet refused to enter and consider the information. Therefore, the petition is DISMISSED"

6. The decision on the petition stated that "[t]he Examiner's Final rejection including the Affidavit is correct and consistent with Office Policy and practice. Accordingly, the Petition is DENIED."

III. Reasons Why the Decisions on the Petition Should Both Be Reconsidered and Reversed

The dismissal of the decision is improper because the basis for dismissal relies upon a the applicant's presumed motivation for requesting removal of final status, not whether final status is or is not in fact proper under Office procedure. Therefore, the dismissal of the petition is erroneous and should be reversed.

The denial of the petition is improper because it is an interpretation of sections of the MPEP in 2144.03 that are in direct contradiction to 37 CFR 1.104(d)(2). The MPEP does not have the force and effect of law, and 37 CFR 1.104(d)(2) does have the force and effect of law.² Moreover, the interpretation in the decision is a strained interpretation imputing procedure regarding prior art references to procedure involving an examiner's alleged personal knowledge, whereas 37 CFR 1.104(d)(2) is directly applicable to an examiner's personal knowledge.

37 CFR 1.104(d)(2) requires that, if the applicant calls for the examiner to provide an affidavit of a previous allegation of personal knowledge in support of a rejection, that "***such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.***" The only possible way for the examiner's affidavit to be "***subject to contradiction or explanation by the affidavits of the applicant and other persons***" is if the applicant has the right to respond to the office action in which the examiner provides his or her affidavit. The only way for that to occur, is if the office action in which the examiner provides his or her affidavit is not final. Thus, any interpretation of 37 CFR 1.104(d)(2) requires the office action in which the examiner first provides his or her declaration be a non final office action.

I note that 37 CFR 1.104(d)(2) is based upon due process considerations and therefore is most likely constitutionally mandated. Therefore, violation of 37 CFR 1.104(d)(2) is also a

²USPTO rules have the force and effect of law. In re Rubinfeld, 270 F.2d 391, 123 USPQ 210 (CCPA 1959), cert. denied, 362 U.S. 903, 124 USPQ 535 (1960). The MPEP does not have the force and effect of law. Refac Int'l, Ltd. v. Lotus Dev. Corp., 81 F.3d 1576, 1584 n.2, 38 USPQ2d 1665, 1671 n.2 (Fed. Cir. 1996).

violation of the applicant's constitutional rights.

Final status would not be proper based upon the fact that the applicant amended the claims in the amendment filed October 23, 2002, because no claim amendment narrowed the scope of any claim, and therefore any prior art rejection of the original claims would have been equally applicable to the amended claims.

Final status would also not be proper because the rejections of claims 32-70 were in fact rejected for the first time on the final office action mailed 11/22/2002.

In summary, there was no basis for making the 11/22/2002 office action final.

IV. Conclusion

The dismissal of the petition is improper because it is not based upon application of Office procedure. Denial of the petition is improper because it is a violation of 37 CFR 1.104(d)(2), the applicant's constitutional due process rights, and not otherwise proper.

8/11/03
Date

Respectfully Submitted,


Richard A. Neifeld, Ph.D.

Registration No. 35,299

Attorney of Record

31518

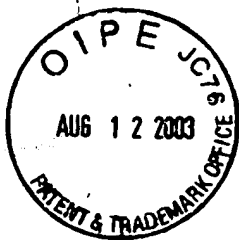
PATENT TRADEMARK
OFFICE

Printed: August 11, 2003

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Attachment 1

3/17/03
RB



Neifeld IP Law, P.C.
Crystal Plaza 1, Suite 1001
2001 Jefferson Davis Highway
Arlington, VA 22202

Neifeld IP Law Docket No.: CAT/29US-SCROCO

Application Serial No.: 09/401,939

Filed: 09/23/99

Inventor: Michael Scroggie, et al.

Title: SYSTEM AND METHOD FOR PROVIDING SHOPPING AIDS AND
INCENTIVES TO CUSTOMERS THROUGH A COMPUTER
NETWORK

The following has been received in the U.S. Patent Office on the date stamped hereon:

CHECK FOR \$130.00

37 CFR 1.181 PETITION TO REMOVE FINAL STATUS

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Pet - CAT29US-SCROCO - 030317 RB

✓ NEIFELD IP LAW, PC
DATE : Mar 13/2003
CHE # : 00807
AMOUNT: \$130.00
ACCOUNT: GENERAL - 1
PAID TO: Commissioner of Patents
Commissioner of Patents
Washington, DC
DC
20251

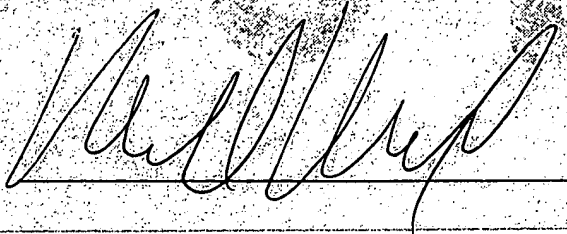


000807

CAT/29US-SCROCO petition fee

CLIENT: CATA - Catalina Marketing Corporation
MATTER: CAT29USSCRO

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AUG 15 2003
GROUP 3600.

NEIFELD IP LAW, PC 2001 JEFFERSON DAVIS HIGHWAY, SUITE 1001 ARLINGTON, VA 22202		BURKE & HERBERT BANK & TRUST CO. Alexandria, VA	CHECK NO. 68-106/560	00807 000807
One Hundred Thirty *****				00/100
PAY TO THE ORDER OF	DATE	AMOUNT		
Commissioner of Patents Commissioner of Patents Washington, DC, DC 20251	Mar 13/2003	\$130.00		
CAT/29US-SCROCO petition fee				MP

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NEIFELD IP LAW, PC
DATE : Mar 13/2003
CHE # : 00807
AMOUNT: \$130.00
ACCOUNT: GENERAL - 1
PAID TO: Commissioner of Patents
CAT/29US-SCROCO petition fee
CLIENT: CATA - Catalina Marketing Corporation
MATTER: CAT29USSCRO
LAWYER: Richard A. Neifeld
200 Carillon Parkway

**** GENERAL BALANCES ****
UNBILLED DISBS:
A/R BALANCE :

**** TRUST BALANCES ****

000807
750.00
0.00

St. Petersburg
FL
33716

TRUST BALANCE : 0.00

CAT29/US-SCRO and all applications having the same disclosure



DOCKET NO: CAT/29US-SCROCO
PRIOR DOCKET NO.: 7791-0087-25 CONT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:
MICHAEL C. SCROGGIE ET AL.

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: GROUP: 3622

APPLICATION NUMBER: 09/401,939

: EXAMINER: GRAVINI, S.

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FOR: SYSTEM AND METHOD FOR PROVIDING SHOPPING AIDS AND INCENTIVES
TO CUSTOMERS THROUGH A COMPUTER NETWORK

37 CFR 1.181 Petition to Remove Final Status

I. Statement of the Relief Requested

The applicant petitions to have the final status removed to the extent necessary to admit the evidence attached to the applicant's appeal brief.

II. Statement of the Material Facts

1. In the office action prior to the final office action, the examiner relied upon alleged personal knowledge, for the first time in this application, to rejections under 35 USC 102/103.

2. In response to that non-final office action, the applicant submitted evidence and arguments contrary to the examiner's alleged personally knowledge. The undersigned spoke with a third party in a position of personal knowledge whose knowledge contradicted the examiner's factual assertions. (Mr. Ruggieri, the web master of performancebike.com.) The applicant pointed out in the response to the non-final office action that the examiner had not given a declaration, and that if the examiner did give a declaration, the applicant would seek a declaration from third party witness (Mr. Ruggieri), i.e, submit additional evidence.

3. The examiner responded by giving a declaration and making his office action status "final."

4. The applicant is filing an appeal brief concurrently with this petition containing 9 attachments, which are each evidence tending to contradict the examiner's assertions in his declaration supporting his rejections of claims in this application.

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III. Statement of the Reasons Why the Relief Requested Should be Granted

The final status of the application is improper because the examiner's declaration is new evidence in support of his personal knowledge based prior art rejections and therefore final status is improper. Accordingly, the evidence submitted in conjunction with the appeal brief should be entered and considered in the appeal.



31518

PATENT TRADEMARK
OFFICE

3/13/03
Date

Respectfully Submitted,


Richard A. Neifeld, Ph.D.

Registration No. 35,299

Ruay Lian Ho

Registration No. 48,110

Printed: March 13, 2003

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atus_030313.wpd